

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of	:	
Olaf Vancura	:	Group Art Unit: 3714
	:	
Serial No.: 10/712,735	:	Supervisory Primary Examiner:
	:	Robert E. Pezzuto
	:	
Filed: November 13, 2003	:	Examiner: Adetokunbo Olusegun Torimiro
	:	
For: GAMING MACHINES WITH	:	
BONUSING	:	Conf. No.: 8906
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**REQUEST TO PRIMARY EXAMINER UNDER MPEP 706.07(d) TO  
WITHDRAW THE FINAL REJECTION AS PREMATURE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313

To Supervisory Primary Examiner Pezzuto:

The undersigned respectfully submits that the Frohm '897 patent (6,234,897) as applied in the last, made final Office Action cannot be relied upon as a §102(e) reference in the manner proposed by the Examiner because it relies on material in the Frohm '897 patent that is **not** entitled to a priority date before the effective filing date of the present application. Withdrawal of the made final in the last Office Action as being premature is respectfully requested.

The pending application is a continuation application claiming priority through a series of continuations back to March 2, 1999 (original filing date of non-provisional Serial No. 09/260,634, now 6,033,307).

The application maturing into the Frohm '897 patent was filed on August 25, 1999 and claims continuation-**in-part** priority to Frohm '429 (Serial No. 09/140,947 filed August 27, 1998, now 6,203,429). The specifications of Frohm '897 and Frohm '429 are not identical. Frohm '897 (the CIP) contains added sections not found in Frohm '429 (the parent).

Applicant respectfully submits that these added sections cannot be §102(e) prior art against the pending claims of the present application as proposed by the Examiner in the last Office Action as they are not entitled to a date preceding March 2, 1999.

As for example, the Made Final Rejection of the last Office Action relies upon added Figure 12 of Frohm '897 (the CIP) in its §102(e) rejection of claims 60-62 and 66 (see pages 3 and 4 of Final Rejection). This added figure does not appear in Frohm '429 (the parent). This was pointed out in the last Response at page 10 (last paragraph) and page 12 (first paragraph). Applicant respectfully submits that there is no legal basis that an added figure filed after the priority date of the present application can anticipate claims 60-62 and 66. The rejection also relies upon added Figures 10A-10D (and column 8, lines 10-21) of Frohm '897 (the CIP) to reject claims 56-58. These added figures and corresponding discussion are not found in Frohm '429 (the parent).

The Final Rejection relies solely on the Frohm '897 patent (the CIP) as a §102(e) reference to reject all claims except 65 and 68. Frohm '429 (the parent) has not been applied as a reference, under any statutory basis of §102 or §103, against any of the claims in the First Office Action or the Final Rejection.

In the "Response to Arguments" section of the Final Rejection on page 7, it states:

"The Examiner disagrees with the argument of the Applicant that the prior art Frohm '897 is not a prior art because the CIP priority to Frohm '429."

The Applicant appreciates that the portions of Frohm '897 identical to its parent (Frohm '429) are entitled to a date before the above-mentioned March 2, 1999 date of the present application. But, the Examiner also relies on sections added in Frohm '897 (the CIP) beyond its parent and these sections are not prior art to the present application.

It is respectfully submitted that the Final Rejection is premature and that it be withdrawn. It is further respectfully submitted that the Frohm '897 patent (the CIP) is being improperly applied as prior art. Finally, it is respectfully requested that any new or modified Office Action not be made final so that the Applicant can fully respond.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

DORR, CARSON & BIRNEY, P.C.

Date: 3/10/08

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